

## REMARKS

### I. Status of the Claims

Claims 1-28, 36-43, and 45-56 are pending in this application. Claims 29-35 and 44 have been withdrawn from consideration. No claims are amended herein.

### II. Rejection Under 35 U.S.C. § 103(a): Rejection over O'Lenick et al. in view of Arnaud et al.

The Examiner has maintained the rejection of claims 1-28, 36-43, and 45-56 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,342,527 B1 to O'Lenick et al. ("O'Lenick") in view of U.S. Patent No. 6,491,927 B1 to Arnaud et al. ("Arnaud") for the reasons of record and those set forth on pages 2-7 of the Final Office Action. Applicants respectfully disagree and traverse the rejections for the reasons of record and the following additional reasons.

According to the Examiner, it would have been obvious to one of ordinary skill in the art to combine the teachings of O'Lenick with that of Arnaud to arrive at the presently claimed invention. Final Office Action at page 6. The Examiner specifically alleges that "it would have been *prima facie* obvious to one of ordinary skill in the art to combine an esterified triglyceride which results in a polyester with another high molecular weight oil and colorant to create the presently claimed invention." *Id.* at page 7. However, Applicants submit that one of ordinary skill would **not have been motivated** to combine the teachings of O'Lenick with that of Arnaud to arrive at the presently claimed invention. "The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all of the facts." M.P.E.P. §2141 (III). Applicants take the position that after consideration of

all the facts herein, the combination of references relied on by the Examiner does not render the present claims obvious.

As an initial matter, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007).

To ascertain the scope and content of the prior art as compared with the presently claimed invention, Applicants first direct the Examiner to paragraphs [0004] to [0005] at page 1 of the present application as published which explicitly state that:

Numerous cosmetic compositions exist for which gloss properties in the deposited film are desirable following its application to keratin materials. . . . From this viewpoint, a formulator may have a number of types of base materials at his or her disposal, such as...polyesters obtained by sequential reaction of castor oil with isostearic acid and then with succinic acid, which are described in U.S. Patent No. 6,342,527 [O'Lenick].

The Examiner is further directed to paragraph [0006], which states:

In one embodiment, disclosed herein is a glossy cosmetic care and/or makeup composition for keratin materials, such as skin, lips and epidermal derivatives, **which can have improved properties relative to the cosmetic**

**compositions of the prior art.** For example, deposition of the composition disclosed herein on the keratin materials can be **more sharply defined and its color retention can be enhanced.**

(Emphasis added).

“Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” M.P.E.P. §2141.02. Here, O’Lenick as a whole is directed toward improving gloss of cosmetic products using specific polyesters limited to a particular combination of castor oil with fatty acids and diacids. See, e.g., O’Lenick at col. 1, line 36-45. In contrast, the present disclosure as a whole relates not only to improved glossiness of cosmetic products, but also to improving definition and color retention with polyesters that are not limited to castor oil only but may include triglycerides derived from various chemical formulae. See page 2, paragraph [0026], to page 3, paragraph [0061], of the published application. Thus, as noted in the passage from the present specification cited above, the presently claimed invention actually improves upon the limited teachings of O’Lenick. Not only that, as the Examiner admits at page 5 of the Final Office Action, O’Lenick fails to disclose its claimed polyester in combination with an oil having a molar mass ranging from 650 to 10,000 g/mol. Indeed, O’Lenick nowhere teaches or even suggest the possibility of adding an oil to its polyesters at all.

Thus, although the Examiner tries to rely on Arnaud to remedy this deficiency, Applicants submit that, based on the above, O’Lenick itself is hardly an appropriate starting point for an obviousness rejection.

With respect to Arnaud, Applicants assert that Arnaud does not remedy the deficiencies of O'Lenick in such a way as to render the combination of the two teachings obvious. According to the Examiner at page 5 of the Final Office Action, Arnaud teaches the use of saturated and branched C<sub>24</sub> to C<sub>28</sub> fatty alcohol or acid esters, and of at least one additional oil such as hydrogenated polyisobutene, in a cosmetic composition. It is true that such fatty alcohols and acid esters *appear* to be encompassed by the present claims, e.g., present claim 42. However, if one looks closer at Arnaud "as a whole," as is required, Arnaud actually teaches away from the present claims.

Specifically, at col. 1, lines 30-36, Arnaud states that "synthetic liquid esters with high molecular masses, such as pentaerythrityl tetra[isostearate]...can exhibit the disadvantages of lack of slip on application and of a sticky feel for the esters...". Arnaud is therefore distinguishing such esters from its claimed C<sub>24</sub> to C<sub>28</sub> fatty alcohol or acid esters. Yet in the present specification at paragraph [0095] of the published application, pentaerythrityl tetra[isostearate] is disclosed as an example of a useful C<sub>24</sub> to C<sub>28</sub> fatty alcohol or acid ester. Accordingly, Arnaud, when considered as a whole, teaches away from the presently claimed invention, when considered as a whole, because it teaches that certain high molecular mass esters are not desirable to provide good sensory properties of cosmetic products. In contrast, the presently claimed invention illustrates the superior and unexpected results of combining specific polyesters with a broad range of high molecular mass oils.

Thus, for at least these reasons, the combination of these two references does not render the present claims obvious. O'Lenick contains a limited teaching of a certain

polyester and no suggestion of an oil. Arnaud teaches oils overlapping in scope with those presently disclosed, but contains no teaching of the claimed polyester, and teaches away from the presently claimed scope of oils by finding some desirable and some not. The presently claimed composition and method, therefore, provide an advantage over compositions of prior art, since the composition can include various polyesters in combination with various high molecular mass oils to improve not only glossiness but also color retention and definition of cosmetic products. For at least these reasons, Applicants respectfully request withdrawal of this rejection.

### III. Conclusion

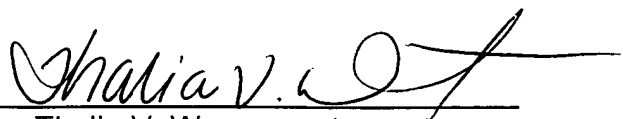
In view of the foregoing remarks, Applicants submit that this claimed invention is not rendered obvious in view of the prior art cited against this application. Applicants therefore request the entry of this Response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Thalia V. Warnement  
Reg. No. 39,064